

**REMARKS**

**I. Status and Disposition of the Claims**

In the instant application, claims 1-27 and 29-30, of which claims 1, 12, 23, 24, 25 and 30 are independent, are pending and under consideration on the merits.

In the Office Action<sup>1</sup> mailed September 19, 2008, the following actions were taken:

1) Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US 2004/0225507, by Smith et al. (herein after "*Smith*") in view of Pub. No. US 2004/0098316, by Philippe et al. (herein after "*Philippe*");

2) Claim 27 was rejected as being obvious over *Smith* and *Philippe* in view of knowledge in the art (page 4) or over *Smith* in view of knowledge in the art (page 6); and

3) Claims 5, 7, 16, 18 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and *Philippe* further in view of Pub. No. US 2002/0019759 by Arunapuram et al. (hereinafter "*Arunapuram*").

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

## **II. Amendments to the Claims**

In this Amendment and Response to the Office Action, Applicant amends claims 1, 12, 23-25, 27 and 30. Support for amendments to claims 1, 12, 23-25, and 30 are found at page 3, para. [004] of the Specification, "For example, a part requested by a customer may have a material availability date (MAD) that represents when the part is available at the source, such as a warehouse." Also, support for the amendment to claim 27 is found at page 22-23, para. [053] of the Specification, "In one embodiment, Planner 104 includes an integrated Global Available-to Promise (gATP) module, which is manufacturing facility," and page 26, para. [060] of the Specification, "Since the sales order request is a rush order, planner 104 first performs a global availability check of all sources that can provide the requested good without any concern for trip duration."

## **III. Response to Rejections**

In this Response to the Office Action, Applicant respectfully traverses the rejection listed above.

### **A. The Rejection of the Claims under 35 U.S.C. §103 is Improper.**

Applicant respectfully traverses the rejection of claims 1-27, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable, because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . [R]ejections on obviousness cannot be sustained with mere conclusory statements."

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained.

Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

**1. Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 are allowable.**

Claims 1-4, 6, 8-15, 17, 19-25, 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Philippe*. See Office Action at page 2. In particular, the Office Action contains the assertion, "it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Smith*, to include the availability date in determining the source location for the goods being independent of the requested delivery date, in order to allow the user to be more informed of the options of delivery and allowing a user to view the same item from different source locations." See Office Action at 3-4. Applicant respectfully disagrees with the assertion and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Smith* and *Philippe* reveal that the references fail to teach or suggest each and every element of amended claim 1, nor do they teach amended independent claim 1 as a whole. In the present case, amended independent claim 1 recites, *inter alia*,

- "receiving . . . a description of the good, . . . and **a requested delivery date**, the good having an **availability date determined independently of the requested delivery date**;"
- "selecting a source location . . . **based on the availability date** of the good at the source location;" and

- "scheduling the trip **based on the requested delivery date**. . . ."

(Emphasis added).

*Smith* does not teach, disclose or suggest claim 1 because it fails to teach, disclose or suggest, at least, "receiving . . . a **requested delivery date**", "the good having an availability date **determined independently of the requested delivery date**", "selecting a source location. . . based on the availability date", and "scheduling the trip **based on the requested delivery date**. . . ." The Office Action confirms this and discloses, "*Smith* discloses selecting a source location for the good . . . based on . . not the availability date of the good at the source location, and does not disclose it is determined independently of the requested delivery date." See Office Action at 3.

*Philippe* fails to cure the deficiencies of *Smith*. That is, *Philippe* also fails to teach, disclose or suggest the above cited elements. The Office Action cites *Philippe*'s Fig. 2C with corresponding detailed description as teaching "displaying a plurality of origins of a good, . . . the availability of the good, i.e. if it is "In Stock" and . . . the shipping time." See Office Action at 3. However, nowhere in these citations, or elsewhere in *Philippe*, is there a mention of "receiving . . . a requested delivery date" or "selecting a source location based on the availability date", as recited in claim 1.

*Philippe*'s Fig. 2C illustrates a "result page 205" "depicting the results of the search performed" and "displayed to the user." See *Philippe* at para. 0053. "[T]he user makes a selection of an item from the result page [and] a transaction is initiated with a site corresponding to a vendor offering the merchandise selected by the buyer". See *id.* However, *Philippe* does not disclose what the user's selection is based on. *Philippe* is

silent on identifying a specific element (such as price, condition or author) that the user considers when selecting an item from the results page. Therefore, nowhere in *Philippe* is there a suggestion of selecting a source location based on an availability date.

Moreover, *Philippe* does not teach, disclose or suggest a requested delivery date. The Office Action appears to indicate that *Philippe*'s "Availability" item in Fig. 2C represents an availability date of the good to be shipped to the user. See *Philippe* at Fig. 2C and Office Action at 3. This is different than a requested delivery date. *Philippe*'s user does not identify a requested delivery date for the good, nor does it schedule the trip based on the requested delivery date. Therefore, nowhere in these citations, or elsewhere in *Philippe*, is there a suggestion of "the good having an availability date determined **independently of the requested delivery date**", of "receiving . . . **a requested delivery date**", nor of "scheduling the trip **based on the requested delivery date** . . ." Therefore, *Philippe* does not teach, disclose or suggest claim 1.

Further, because neither *Smith* nor *Philippe* disclose at least, "selecting a source location comprising an origin for the good based on the availability date of the good at the source location", as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the system of *Smith*, using teachings of *Philippe*, to achieve the required combination recited by claim 1. As noted above, Applicant submits that while examiners may rely

upon what is generally known in the art, they must provide some concrete evidence in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify *Smith*, using the teachings of *Philippe*, so as to arrive at the claimed invention. In particular, the Office Action does not explain at least: (a) *why* one of ordinary skill would use the teachings of *Philippe*, which does not even include a mention of the requested delivery date, to modify *Smith*'s system for planning a delivery of a good in which the requested delivery date is required to schedule the trips, and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and *Philippe* so as to arrive at the above-recited feature of amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and *Philippe* and the known art so as to arrive at the presently claimed methods recited in claim 27. The Office Action contains the assertion, "it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Smith*, to include the availability date in determining the source location for the goods being independent of the requested delivery date, **in order to allow the user to be more informed of the options of delivery and allowing a user to view the same item from different source locations.**" See Office Action at 3-4. (Emphasis added).

At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a

reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and *Philippe* would not result in a predictable variation of Applicant's invention because a hypothetical *Smith* and *Philippe* combination would lack the elements recited in amended claim 1, namely "the good having an availability date **determined independently of the requested delivery date**", "receiving . . . a requested delivery date", and "scheduling the trip **based on the requested delivery date** . . ."

Further, even assuming *arguendo* that the Patent Office's assertion is correct that *Smith* discloses receiving a requested delivery date and that combining *Smith* and *Philippe* allows a "user to be more informed of the options of delivery" and "to view the same item from different source locations," it would miss the objective of the Applicant's recited method, since a method fulfilling the objectives as stated in the Patent Office's assertion, namely allowing a user to be informed of more options of delivery and viewing the same item from different source locations, would not withhold options of delivery, including those options developed using a requested delivery date, which would be withheld in a method incorporating the features recited in Applicant's amended claim 1. Therefore, a hypothetical *Smith/Philippe* combination would miss the objective of the Applicant's recited method, which discloses "the good having an availability date determined independently of the requested delivery date", "selecting a source location comprising an origin for the good based on the availability date", and "scheduling the trip based on the requested delivery date. . ."



For at least this reason, Applicant submits that the Office has not met the burdens necessary to establish that amended claim 1 is obvious under § 103(a). Therefore the § 103(a) rejection of amended claim 1 is improper, and should be withdrawn.

For at least the reasons noted above, claims 12, 23, 24, 25 and 30 which recite similar elements and were rejected under the same rationale, and claims 2-4, 6, 8-11, 13-15, 17, 19-22 and 29 which depend directly or indirectly from claims 12 and 23 are allowable under 35 U.S.C. 103(a).

## **2. Claim 27 is allowable.**

The rejection of claim 27 was based on Official Notice that “the use of Rush orders are well known” and therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify *Smith* and *Philippe*, “to have the user indicate the order is a rush order and schedule accordingly.” See Office Action at 4. Applicant respectfully disagrees with this assertion.

Whether or not rush orders comprise an obvious feature or that the Official Notice was appropriate, in the present case, amended claim 27 recites, *inter alia*, “receiving an instruction for planning the delivery of the order as a rush order by a global available-to-promise module performing a global availability check, wherein planning comprises determining, selection and scheduling the trip forward from the availability date at the source location.” *Smith* and *Philippe* does not teach, disclose or suggest this recited feature. The Office Action confirms this. See Office Action at 4.

Whether or not rush orders comprise an obvious feature, incorporating rush orders into *Smith* and *Philippe* would not result in the invention recited in amended claim 27 as a whole. Claim 27 depends from claim 25, and thus includes all the elements and limitations thereof. As set forth above with respect to amended claim 1, which recite similar elements of claim 25, the features, "receiving . . . a requested delivery date," "selecting a source location . . . based on the availability date for the good at the source location," "scheduling the trip based on the availability date and the requested delivery date" are not found in *Smith* and *Philippe*. Incorporating rush orders into the combination system of *Smith* and *Philippe* would not provide the *Smith* / *Philippe* system with the ability to perform the above features.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of the combination system of *Smith* and *Philippe*, using teachings of the known art to achieve the required combination recited by amended claim 27. As noted above, Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide some concrete evidence** in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the combination of *Smith* and *Philippe*, using the teachings of the known art, so as to arrive at the claimed invention. In particular, the Office Action does not explain at least: (a) *why* one of ordinary skill would modify the steps of *Smith* and *Philippe* so as to "receiv[e] an instruction for planning the delivery of the order as a rush order by a global available-to-promise module performing a global

availability check, wherein planning comprises determining, selection and scheduling the trip forward from the availability date at the source location," and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and *Philippe* and the known art so as to arrive at the above-recited feature of amended claim 27.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and *Philippe* and the known art so as to arrive at the presently claimed methods recited in claim 27. In the present case, however, no such rationale has been provided.

The Office provided the statement that it would have been obvious to make the modifications "to have the user indicate the order is a rush order and schedule accordingly." See Office Action at 4.

At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and *Philippe* and the known art would not result in a predictable variation of Applicant's invention because *Smith* and *Philippe* and the known art lack the elements recited in claim 27, namely "a global available-to-promise module performing a global availability check."

For at least this reason, Applicant submits that the Office has not met the burdens necessary to establish that amended claim 27 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 27 is improper, and should be withdrawn.

**3. Claims 5, 7, 16, 18 and 26 are allowable.**

Claims 5, 7, 16, 18 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* and *Philippe* in further view of *Arunapuram*. See Office Action at page 5. In particular, the Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Smith*, to have the optimal trip selected, based on criteria, such as hazardous material and cost, as disclosed by *Arunapuram*, in order to provide an optimum solution on the customer's needs." See Office Action at 5. Applicant respectfully disagrees and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Smith*, *Philippe* and *Arunapuram* reveal that the references fail to teach or suggest each and every element of claims 5, 7, 16, 18 and 26. In addition, no additional evidence has been raised establishing a tenable rationale that one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

In the present case, claims 5 and 7 recite, "the set of criteria comprises at least one criterion representative of dangerous goods," and "the set of criteria comprises at least one criterion representative of cost information." A system combining *Smith* and

*Philippe* does not teach, disclose or suggest this recited feature. The Office Action confirms this for *Smith* (see Office Action at 5), but it is equally true for *Philippe*. Whether or not *Arunapuram* teaches the elements of claims 5 and 7, incorporating hazardous material and cost criteria into the combination system of *Smith* and *Philippe* would not result in the invention recited in claims 5 and 7 as a whole. Claims 5 and 7 depend from amended claim 1 and thus include all the elements and limitations thereof. As set forth above with respect to amended claim 1, the features in amended claim 1, namely “the good having an availability date **determined independently of the requested delivery date**”, “receiving . . . a **requested delivery date**”, and “scheduling the trip **based on the requested delivery date . . .**” are not found in *Smith* and *Philippe*. *Arunapuram* also does not teach, disclose or suggest the above-recited features of amended claim 1.

The system in *Arunapuram* manages transportation operations by processing information related to the transportation of a good and produces transportation solutions based on this information. See *Arunapuram* at page 16. However, nowhere in *Arunapuram* is there any suggestion of selecting a source location. Therefore, whether or not selecting a trip based on dangerous goods or cost information was disclosed in *Arunapuram*, incorporating these features into *Smith* and *Philippe* would not result in the invention recited in claims 5 and 7 as a whole. Incorporating dangerous goods or cost information criteria into a system combining *Smith* and *Philippe* would not provide the system with the ability to select source locations for goods based on the availability date of the goods at the source location.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of the combination system of *Smith* and *Philippe*, using the teachings of the *Arunapuram* to achieve the required combination recited by claims 5 and 7. As noted above, Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide some concrete evidence** in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Smith* and *Philippe* using the teachings of *Arunapuram*, which does not disclose selecting a source location, so as to arrive at the claimed invention. In particular, the Office has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Smith* and *Philippe* so as to select a trip from the set of trips based on dangerous goods and cost information; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Smith* and *Philippe* and *Arunapuram* (in which best shipping mode is determined by carrier type, equipment, route, etc.) so as to arrive at the claimed feature of "the set of criteria comprises at least one criterion representative of dangerous goods," and "the set of criteria comprises at least one criterion representative of cost information," as recited in claims 5 and 7.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Smith* and *Philippe* and *Arunapuram* so as to arrive at the presently claimed methods recited in claims 5 and 7. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that adding the feature of *Arunapuram* to a system combining *Smith* and *Philippe* is "in order to provide an optimum solution based on the customer's needs." See Office Action at 5. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Smith* and *Philippe* and *Arunapuram* would not result in a predictable variation of Applicant's invention because *Smith* and *Philippe* and *Arunapuram* require additional information regarding the availability date of the good at the source location to be able to select a source location for the goods ordered. Further, even assuming *arguendo* that the assertion is correct that a system combining *Smith* and *Philippe* and *Arunapuram* provides an optimum solution based on the customer's needs, it still does not result in a predictable variation of Application's invention since selecting a source location based on availability of the good at the source location is not a part of any of the systems disclosed in these references. Therefore, it misses the objective of the Applicant's system, which discloses "selecting a source location for the good based on the availability date of the order at the source location."

For at least this reason, a *prima facie* case of obviousness with respect to claims 5 and 7 have not been proved. The rejection of claims 5 and 7 under 35 U.S.C. §103(a)

as being obvious from *Smith* and *Philippe* in view of *Arunapuram* is thus improper and should be withdrawn.

For at least the reasons noted above, claims 16, 18 and 26, which recite similar elements rejected under the same rationale, are allowable under 35 U.S.C. §103(a).  
See Office Action at 4.

#### **IV. Conclusion**

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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